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Amdt. dated July 14, 2005
Reply to Office Action of July 29, 2004

<u>Remarks</u>

The present amendment responds to the Official Action dated May 5, 2005. The Official Action rejected claims 1 and 16 under the judicially created doctrine of obviousness-type double patenting over claim 22 of Adamac et. al U.S. Patent No. 6,243,690 (Adamac). Claims 1, 3-5, 8-15, and 21 were rejected under 35 U.S.C. §112, second paragraph due to insufficient antecedent basis of the term "host computer." The Official Action rejected claims 1, 3-5, and 8-21 under 35 U.S.C. §102(b) based on Goodwin III U.S. Patent No. 5,854,474 (Goodwin '474). Claims 1, 3-5, and 8-21 were rejected under 35 U.S.C. §102(b) based on Goodwin III U.S. Patent No. 5,907,143 (Goodwin '143). Claims 1, 3-5, and 8-21 were alternatively rejected under 35 U.S.C. §103(a) based on Goodwin '474. Claims 1, 3-5, and 8-21 were alternatively rejected under 35 U.S.C. §103(a) based on Goodwin '143. These grounds of rejection are addressed below following a brief discussion of the present invention to provide context.

Although Applicants do not acquiesce in the obviousness-type double patenting rejection, a terminal disclaimer is concurrently being filed herewith to obviate this rejection.

Claims 1 and 16 have been amended to be more clear and distinct. Support for the present amendment can be found, for example, in Fig. 3 and the discussion of this figure in the present specification. Claims 2, 6, and 7 have been previously cancelled. Claims 1, 3-5, and 8-21 are presently pending.

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The Present Invention

One aspect of the present invention relates to improvements in systems and methods

which combine electronic price labels (EPLs) and electronic signs (ESs). As discussed in greater

detail below, Goodwin '143 addresses an approach for an EPL system to also display

promotional messages. In this approach, the promotional indicators are tied to an item record

within a price lookup (PLU) file. As addressed at page 1, lines 16-21 of the present application,

such an approach does not allow retailers to utilize an EPL which displays promotional

information relating to groups of items or general sales events. With the prior art approach in

which an EPL is assigned to a single item, a retailer cannot effectively advertise prices, such as

bundled prices, that involve two or more different items. See also, page 2, lines 7-23.

As addressed in detail at page 6, line 1 – page 7, line 3, the present invention

advantageously allows retailers to utilize an electronic sign (ES), such as ES 123 of Fig. 3, to

display a promotion message without the ES being associated with an ITEM ID in a PLU file,

such as PLU file 107. See, particularly, page 6, lines 17 and 18. To this end, ES 123 is

associated with a promotional identification number in an EPL/ES data file, such as data file 109,

and there is no associated promotional identification number in the PLU file. Thus, the PLU file

may advantageously be modified and replaced without regard to promotional messages.

Furthermore, electronic signs may advantageously be located in a store away from the product or

products it promotes. See present application, at page 6, line 17 – page 7, line 3, for example.

The claims as presently amended address a combined EPL and ES system or a method of

operating such a system. Taking claim 1, by way of example, that claim requires an EPL/ES data

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file to have an identification number capable of being both a promotion identification number and an item identification number. The host computer reads this file to determine "whether the identification number stored in the EPL/ES data file is a promotion identification number associated with the ES or an item identification number associated with an EPL," thereby allowing improved flexibility as discussed in greater detail in the present application.

Interview Summary

The Examiner is thanked for the courtesy of a telephone interview concerning the above case on July 5, 2005. In this telephone call, the deficiencies of Goodwin '143 and Goodwin '474 as outlined in the Art Rejection section below were discussed with regards to claim 1. The Examiner posited that the conjunction "or" found in the limitation "to determine whether the identification number stored in the EPL/ES data file is a promotion identification number associated with the ES or an item identification number associated with an EPL," would be anticipated if art showed either a promotion identification or item identification number in an EPL/ES data file. The Examiner agreed with the arguments discussed below if a claim amendment was made to reflect, in concept, that the identification number stored in the EPL/ES file can be both a promotion identification number and an item identification number. In response to this interview, claims 1 and 16 have been amended accordingly. Presently amended claim 1 now recites "a host computer reading a combined EPL/ES data file separate from the PLU file and having a field for storing both promotion identification numbers and an item identification numbers, the host computer determining whether a particular identification number

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stored in said field of the EPL/ES data file is a promotion identification number associated with

an ES or an item identification number associated with an EPL." Presently amended claim 16

now recites "(a) reading a record associated with an EPL or an ES from a combined EPL/ES

data file separate from a price lookup (PLU) file, the record having a field for storing both a

promotion identification number and an item identification number; (b) determining whether a

particular identification number stored in said field of the combined EPL/ES data file is a

promotion identification number associated with an ES or an item identification number

associated with an EPL."

Section 112, Second Paragraph Rejection

After reviewing both the Private Pair system and the amendment faxed January 19, 2005,

claim 1 has been apparently misscanned because the article "a" already preceded the term "host

computer" in the amendment but the Private Pair system showed the article "a" struck out.

Consequently, this rejection is traversed.

The Art Rejections

As addressed in greater detail below, Goodwin '474 and Goodwin '143 do not support

the Official Action's reading of them and the rejections based thereupon should be reconsidered

and withdrawn. Further, the Applicant does not acquiesce in the analysis of Goodwin '474 and

Goodwin '143 made by the Official Action and, in light of the presently amended claims,

respectfully traverses the rejections.

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Claims 1-5 and 8-21 were rejected under 35 U.S.C. §102(b) based upon Goodwin '474.

Goodwin '474 advantageously addresses an electronic sign having a number of two dimensional

bar code readers. The bar code readers read a two dimensional bar code label on a back side of a

corresponding number of item description cards. The two dimensional bar code label contains

price data for the item associated with the item listed on the item description card and may

additionally contain promotional data. Goodwin '474, col. 1, lines 31-41. The electronic sign

displays the information read by the bar code readers.

Goodwin '474 does not disclose and does not make obvious "a host computer reading a

combined EPL/ES data file separate from the PLU file and having a field for storing both

promotion identification numbers and an item identification numbers, the host computer

determining whether a particular identification number stored in said field of the EPL/ES data

file is a promotion identification number associated with an ES or an item identification number

associated with an EPL" as presently claimed in claim 1. Goodwin '474 discloses a storage

medium in an electronic sign for storing price information and promotional information read

from a bar code label using an included bar code reader.

The Official Action relies on Goodwin '474 as purportedly disclosing the claimed

invention including "a EPL 10 having a separate promotional file (storing the promotional

message); a PLU (storing the price of the item); reading the promotional message from the

promotional data file and sending it to the ES (inherent in any promotional message system)."

Applicants respectfully disagree. Goodwin '474 does not address a combined price label (EPL)

and electronic system as presently claimed. For example, Goodwin '474 does not disclose and

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does not make obvious "a plurality of EPLs", "a promotional data file", "a price lookup file", and

"a host computer" in the manner claimed. Goodwin '474 merely discloses an electronic sign

having a bar code reader which reads and displays information printed on a bar code label.

In the alternative §103 rejection discussed below, the Official Action, referring to the

§102 rejection, states "it is inherent that when a computer reads an identification number (such as

the keyed field in a relational database system) in EPL/ES file, type checking (inherent in

programming languages) alone determines if the identification number is associated with the ES

or EPL." Applicants respectfully disagree. This analysis is technically incorrect. Type checking

is typically performed during compilation of a computer program. The determination in claim 1

made by the host computer is performed during operation of the combined EPL/ES system, not

during compilation of control software. Regardless of whether type checking is performed

during compilation or run-time, Goodwin '474 does not disclose and does not make obvious "a

host computer reading a combined EPL/ES data file separate from the PLU file and having a

field for storing both promotion identification numbers and an item identification numbers, the

host computer determining whether a particular identification number stored in said field of the

EPL/ES data file is a promotion identification number associated with an ES or an item

identification number associated with an EPL," as presently claimed in claim 1.

Claims 1, 3-5, and 8-21 were alternatively rejected under 35 U.S.C. §103(a) based on

Goodwin '474. The Official Action suggests that even if determining between promotion

identification number and an item identification number is not inherent, a person of ordinary skill

in the art would "modify Goodwin '474 to implement the system is[sic] a relational database

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system." This abstract statement appears to have no relevancy. In light of the present

amendment to claims 1 and 16, if the Examiner continues to maintain this rejection, Applicants

request that the Examiner provide references that include a relational database with "a combined

EPL/ES data file separate from the PLU file and having a field for storing both promotion

identification numbers and an item identification numbers, the host computer determining

whether a particular identification number stored in said field of the EPL/ES data file is a

promotion identification number associated with an ES or an item identification number

associated with an EPL," as presently claimed in claim 1. See also presently amended claim 16.

Claims 1-5 and 8-21 were rejected under 35 U.S.C. §102(b) based upon Goodwin '143.

Goodwin '143 advantageously addresses a method of displaying a promotional message by an

electronic price label (EPL). Goodwin '143, col. 1, lines 18-20. To this end, Goodwin '143

utilizes a promotional data file along with a price lookup (PLU) file. The promotional data file

stores a promotional message and an associated promotional indicator. The PLU file stores an

item's price and a promotional indicator associated with the item. (emphasis added) To display

the promotional message, Goodwin '143's EPL computer reads the PLU file to obtain the

promotional indicator for an item and retrieves the promotional message from the promotional

data file. Goodwin '143, Fig. 4, steps 48 and 52. Goodwin '143's does not disclose an "a

combined EPL/ES data file separate from the PLU file and having a field for storing both

promotion identification numbers and an item identification numbers," as claimed in presently

amended claim 1. See also presently amended claim 16.

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Unlike Goodwin '143, the present invention removes the dependency between a promotional message and an item by introducing "a combined EPL/ES data file separate from the PLU file and <u>having a field for storing both promotion identification numbers and an item identification numbers</u>," as presently claimed in claim 1. (emphasis added) By having an EPL/ES data file structured in the way claimed, the present invention advantageously provides support for electronic signs which are not associated with a particular item. Furthermore unlike Goodwin '143, a PLU file will not require a promotion identification number. Thus, the PLU file may be modified or replaced without regard to promotions being offered at a store. For example, a local store may offer promotions tailored to the inventory of the local store while receiving PLU files from a corporate office. In this example, the local store's system could download replacement PLU files and not be concerned with having to modify them to support the local store's promotions. To display a promotional message at an electronic sign, a host computer reads an EPL/ES data file which is separate from a PLU file. The host computer further reads the promotional message corresponding to the promotional identification number from a promotional data file. Since the dependency of a PLU file is removed, the PLU file may then be modified or replaced independently from offered promotions.

Claim 1, as presently amended, reads as follows:

>   1. (currently amended): A combined electronic price label (EPL) and electronic sign (ES) system comprising:
>
>   a plurality of electronic signs (ESs) for displaying promotional messages associated with promotion identification numbers;
>
>   a plurality of EPLs;
>
>   a promotional data file;

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     a price lookup (PLU) file; and

     a host computer reading <u>a combined EPL/ES data file</u> separate from the PLU file and <u>having a field for storing both promotion identification numbers and an item identification numbers, the host computer determining whether a particular identification number stored in said field of the EPL/ES data file is a promotion identification number associated with an ES or an item identification number associated with an EPL</u>, and, when the promotion identification number is associated with an ES, said host computer reading the promotional message corresponding to the promotion identification number from the promotional data file and sending a message to the ES which includes a command for the ES to display the promotional message. (emphasis added)

Goodwin '143 does not disclose and does not make obvious "a combined EPL/ES data file separate from the PLU file <u>and having a field for storing both promotion identification numbers and an item identification numbers</u>," as presently claimed in claim 1. (emphasis added) Goodwin '143 does not disclose and does not make obvious "the host computer determining whether a particular identification number stored in said field of the EPL/ES data file is a promotion identification number associated with an ES or an item identification number associated with an EPL," as presently claimed in claim 1. See also claim 16. Goodwin '143 merely discloses reading a promotion identification number from a PLU file.

In the alternative §103 rejection discussed below, the Official Action, referring to the §102 rejection, states "it is the Examiner's principal position that the claims are anticipated because an EPL is a form of electronic sign." Although Applicants do not acquiesce to this analysis, even assuming this statement to be true, the claims are distinguishable in light of the present amendment as discussed above.

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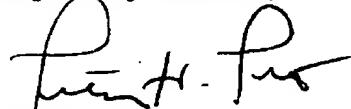Reply to Office Action of July 29, 2004

Claims 1, 3-5, and 8-21 were alternatively rejected under 35 U.S.C. §103(a) based

on Goodwin '143. The Official Action suggests that a person of obvious skill in the art

would modify Goodwin '143 to add additional EPLs as an electronic sign to allow

multiple signs within the same system. Such an analysis fails to address the terms of the

claims before this amendment as well as the terms as presently amended.

The relied upon references fail to recognize and address the problem of isolating a

PLU file by incorporating an identification number capable of being both a promotional

identification number and an item identification number in an EPL/ES data file in the

manner advantageously addressed by the present claims. The claims as presently

amended are not taught, are not inherent, and are not obvious in light of the art relied

upon.

Conclusion

All of the presently pending claims, as amended, appearing to define over the applied

references, withdrawal of the present rejection and prompt allowance are requested.

Respectfully submitted,

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